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U.S. PATENT & TRADEMARK OFFICE

United States Court of Appeals for the Federal Circuit

Mark Vincent Shoen,

Appellant,

v.

United States Patent and Trademark Office,

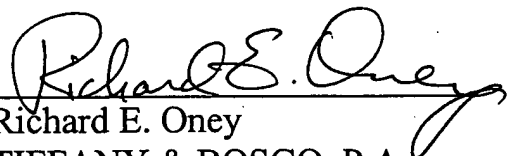
Appellee.

Notice of Appeal

Notice is hereby given that Mark Vincent Shoen hereby appeals to the United States Court of Appeals for the Federal Circuit from the Decision on Appeal, Appeal No. 2005-1910, U.S. Application No. 09/557,459, of the Board of Patent Appeals and Interferences for the United States Patent and Trademark Office, which was entered on October 31, 2005.

DATED this 29th day of December, 2005.

By



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Attorneys for Appellant

Proof of Service and Certificate of Mailing

Re: Mark Vincent Shoen v. United States Patent and Trademark Office
Notice of Appeal from Decision on Appeal of
BPAI Appeal No. 2005-1910 for U.S. Application No. 09/557,459
Attorney File No.: 12521-011

PROOF OF SERVICE PURSUANT TO FED. R. APP. P. RULE 25(d)

I hereby certify that the Notice of Appeal and a courtesy copy of the Decision on Appeal being appealed are being deposited on December 29, 2005 with the U.S. Postal Service "Express Mail Post Office to Addressee" (Express Mail Label No. ER 627127810 US), postage prepaid and addressed to:

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Attn: Office of the Solicitor
Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450


Louis A. Lofredo, paralegal

12-29-05
Date of Signature

I hereby certify that three copies of the Notice of Appeal, a courtesy copy of the Decision on Appeal being appealed and a check in the amount of \$250.00 are being deposited on December 29, 2005 with the U.S. Postal Service "Express Mail Post Office to Addressee" (Express Mail Label No. ED 984391529 US), postage prepaid and addressed to:

Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place, NW
Washington, D.C. 20439


Louis A. Lofredo, paralegal

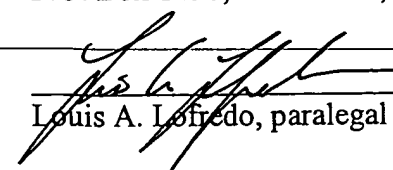
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CERTIFICATE OF MAILING PURSUANT TO 37 C.F.R. § 1.10

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Louis A. Lofredo, paralegal

12-29-05
Date of Signature

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MARK VINCENT SHOEN

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2005-1910
Application No. 09/557,459

ON BRIEF¹

Before NASE, CRAWFORD, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3, 6, 7, 9 to 13, 15 to 17, 19, 20, 23, 24 and 27 to 39. Claims 25 and 26 have been withdrawn from consideration. Claims 4, 5, 8, 14, 18, 21 and 22 have been canceled.

We AFFIRM-IN-PART.

¹ On September 16, 2005, the appellant waived the oral hearing scheduled for October 19, 2005.

BACKGROUND

The appellant's invention relates to trailer and tow dolly fenders and more particularly to a trailer and tow dolly fender having an offset light housing (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Whitton	1,440,516	Jan. 2, 1923
Caponi	2,001,705	May 21, 1935
Hardwick	4,027,808	June 7, 1977
Poveromo (Poveromo '749)	4,395,749	July 26, 1983
Poveromo (Poveromo '664)	4,422,664	Dec. 27, 1983

Claims 34 to 38 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Whitton.

Claims 1 to 3, 6, 7, 9, 17, 29 to 31 and 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Whitton in view of Caponi.

Claims 32 and 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Whitton in view of Caponi and Hardwick.

Claims 1 to 3, 6, 9 to 13, 15 to 17, 19, 20, 23, 24 and 27 to 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Poveromo '664 in view of Poveromo '749.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed September 7, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed May 28, 2004) and reply brief (filed October 22, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection based on Whitton

We will not sustain the rejection of claims 34 to 38 under 35 U.S.C. § 102(b) as being anticipated by Whitton.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Whitton's invention relates to an attachment for the front end of an automobile. As shown in Figures 1-4, the automobile includes, inter alia, front wheels mounted on an axle 1; side channels 2 of the frame; front fenders 3; radiator 4; and a bar 5 which extends over the radiator from fender to fender. The bar 5 is secured to the fenders 3 and their supports 6 as shown in Figure 4. The fender 3 (as best depicted in Figure 4) consists of a lower horizontal portion, an inclined portion extending upwardly from the lower horizontal portion, a slightly curved horizontal upper portion extending away from the inclined portion and a vertical portion extending downwardly from the slightly curved horizontal upper portion. The support 6 (as best depicted in Figure 4) consists of a lower vertical portion (interfacing with the vertical face of the side channel 2), an

inclined portion extending upwardly from the lower vertical portion (interfacing with the inclined portion of the fender 3) and a slightly curved horizontal upper portion extending away from the inclined portion (interfacing with the slightly curved horizontal upper portion of the fender 3).

Whitton does not anticipate claims 34 and 35 since the inclined portion of Whitton's fender 3 is not concave. The examiner's ascertainment that Figures 1 and 3 of Whitton clearly show the inclined portion of Whitton's fender 3 as being obviously concave in a direction from the front of the fender toward the rear of the fender is based on sheer speculation. Anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In this case, the inclined portion of Whitton's fender 3 is not necessarily concave. As such, the subject matter of claims 34 and 35 are not anticipated by Whitton.

Whitton does not anticipate claims 36 to 38. Whitton's fender 3 does not include an inner wall as recited in claims 36 to 38. The examiner's position that Whitton's support 6 is part of the fender is without merit. It is our determination that one skilled in this art would not consider Whitton's support 6 to be part of a fender. Clearly, Whitton's fender 3 by itself does not include an inner wall as recited in claims 36 to 38. As such, the subject matter of claims 36 to 38 are not anticipated by Whitton.

For the reasons set forth above, the decision of the examiner to reject claims 34 to 38 under 35 U.S.C. § 102(b) as being anticipated by Whitton is reversed.

The obviousness rejections utilizing Whitton

We have reviewed the references to Caponi and Hardwick additionally applied in the rejection of claims 1 to 3, 6, 7, 9, 17, 29 to 33 and 39 but find nothing therein which makes up for the deficiency of Whitton discussed above with respect to claims 36 to 38. Specifically, the applied prior art would not have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Whitton's fender 3 to include an inner wall as recited in these claims. Accordingly, the

decision of the examiner to reject claims 1 to 3, 6, 7, 9, 17, 29 to 31 and 39 under 35 U.S.C. § 103 as being unpatentable over Whitton in view of Caponi is reversed and the decision of the examiner to reject claims 32 and 33 under 35 U.S.C. § 103 as being unpatentable over Whitton in view of Caponi and Hardwick is reversed.

The obviousness rejections utilizing Poveromo '664

We sustain the rejection of claims 1 to 3, 6, 9 to 13, 15, 16, 19, 23, 27, 36 and 39 under 35 U.S.C. § 103 as being unpatentable over Poveromo '664 in view of Poveromo '749 but not the rejection of claims 17, 20, 24, 28 to 35, 37 and 38.²

Poveromo '664 pertains to boat trailer fenders and a support bar for the trailer lights and license plate. The fenders are constructed in a single unitary piece and contoured to fit over the wheels of the trailer and to pivotably support the lamp and license plate support bar. The bar is movable to the front of the trailer prior to launching of a boat so that the lamp and associated electrical wiring will not contact the water and get wet during launching of the boat. Figure 1 shows fenders 20 and 22 on a boat

² Claims 17 and 28 include the limitation that "said angle formed by said top portion and said clearance increasing portion, and the angle formed by said clearance increasing portion and said inner wall add up to approximately 90°." In our view, the two angles add up to approximately 270°, not the approximately 90° claimed. As shown in Figure 7, the angle formed by the top portion 20 and the clearance increasing portion 22 is 135° and the angle formed by the clearance increasing portion 22 and the inner wall 26 is 135°. The appellant should correct this error.

trailer 10. The fenders 20 and 22 are identical in structure and, for the sake of brevity, only one will be discussed. Fender 22, as best seen in Figures 2, 3 and 4 has a base 32 integrally constructed with a semi-circular portion 34 having downwardly extending segments 36 and 38 for fitting over the wheels of the trailer. The base 32 is generally planar in configuration having a rearward end 40 and forward end 42 each extending generally perpendicular to the segments 36 and 38. The base 32, semi-circular portion 34 and depending segments 36 and 38 are molded in a unitary piece from a suitable mold. A bar 50 is attached to a top base 32 of each fender in an offset manner as shown in Figures 1 and 3. Each bar 50 is pivotable about a vertical axis 52 by a bolt 54 which extends through an aperture 56 in the bar 50 and threaded into an aperture 58 in the base 32. By this arrangement, the bar may be swung 180° about a horizontal arc on the pivot bolt 54. A bracket 58 is attached to an end 60 of each bar 50 and has a front surface 60 for supporting a lamp 62 thereon. Identification indicia such as a license plate (not shown) may be mounted adjacent to a lamp 62 on the bracket 58.

Poveromo '749 pertains to boat trailers having rear lights and license plate supports which are movable to a position where the lamps and associated electrical wiring will not get wet during launching of a boat from the trailer into the water. Figure 1 shows a boat trailer 10 having the usual cradle 20 for supporting a boat 22 having an outboard motor 24. The wheels of the trailer 10 have fenders 26 (one shown) which

span the multiple wheels 12 and 14 as best seen in Figures 2 and 7 or fenders 28 (one shown) for the single axle trailer as best seen in Figure 4. Figures 4 and 5 illustrate one form of the invention wherein a solid base bar 82 is fastened to the fender 28 by brackets 84 and 86 and nuts and bolts 88. A hollow bar 90 is pivotably attached to the bar 82 by a bolt 92 which extends through apertures 94 (one shown in the bar) and aperture 96 in the bar 82. When the trailer is being hauled over the road, the bar 90 with lamp 78 and identification indicia such as a license plate (not shown) is in the rearward position such that the lamp 78 and license plate are behind the trailer as is required. A bolt 98 extends through apertures 99 (one shown) in bar 90 and through an aperture 100 in the bar 82. Prior to launching the boat from the trailer into the water, the bolt 98 is removed by hand and the bar 90 is rotated 180° about the vertical axis of the bolt 92 to a position forward of the trailer fender 28.

In this rejection, the examiner determined (answer, p. 7) that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of the Poveromo' fender mounted light housing arrangements and mounted the light housing in an offset manner such as shown by Poveromo '664 utilizing a more simpler base portion such as shown by Poveromo '749 which conforms to the curved portion of the fender as disclosed by the Poveromo references for mounting a light housing to the fender of a trailer to reduce manufacturing cost and add more clearance between the light housing in reference to the trailer bed as clearly depicted in figure 1 of Poveromo '664 as a matter of design choice dependent only upon users preference and the vehicles intended use.

With respect to claims 20 and 24, the appellant argues (brief, p. 13) that neither Poveromo '664 nor Poveromo '749 teach or suggest the use of the claimed fender in a tow dolly or contain any disclosure whatsoever concerning tow dollies. We agree. Accordingly, the decision of the examiner to reject claims 20 to 24 under 35 U.S.C. § 103 as being unpatentable over Poveromo '664 in view of Poveromo '749 is reversed.

With respect to claims 17 and 29 to 35, the appellant argues (brief, p. 13) that neither Poveromo '664 nor Poveromo '749 teach or suggest a concave clearance increasing portion. We agree. Accordingly, the decision of the examiner to reject claims 17 and 29 to 35 under 35 U.S.C. § 103 as being unpatentable over Poveromo '664 in view of Poveromo '749 is reversed.

With respect to claim 28, the appellant argues (brief, p. 14) that neither Poveromo '664 nor Poveromo '749 teach or suggest the entire bottom edge of the clearance increasing portion, the entire bottom edge of the inner wall, the entire bottom edge of the top portion, and the entire bottom edge of the outer wall to all lie in a common plane. We agree. Accordingly, the decision of the examiner to reject claim 28 under 35 U.S.C. § 103 as being unpatentable over Poveromo '664 in view of Poveromo '749 is reversed.

With respect to claim 36, the appellant argues (brief, p. 14) that neither Poveromo '664 nor Poveromo '749 teach or suggest a fender comprising a "top portion having a continuous curved upper surface and opposed inner and outer edges." We do not agree. As clearly shown in Figure 4 of Poveromo '749, fender 28 has a "top portion having a continuous curved upper surface and opposed inner and outer edges." Accordingly, the appellant's argument is unpersuasive and the decision of the examiner to reject claim 36 under 35 U.S.C. § 103 as being unpatentable over Poveromo '664 in view of Poveromo '749 is affirmed.

With respect to claims 37 and 38, the appellant argues (brief, p. 15) that neither Poveromo '664 nor Poveromo '749 teach or suggest a fender having a uniform cross-section. We agree. In that regard, we note that the fender 28 of Poveromo '749 is not inherently of uniform cross-section. Accordingly, the decision of the examiner to reject claims 37 and 38 under 35 U.S.C. § 103 as being unpatentable over Poveromo '664 in view of Poveromo '749 is reversed.

With respect to claims 1 to 3, 6, 9 to 13, 15, 16, 19, 23, 27 and 39, the appellant argues (brief, pp. 12-13) that the combined teachings of Poveromo '664 and Poveromo '749 do not teach or suggest a light housing attached to the curved surface of the top portion of the fender. We do not agree. As clearly shown in Figure 4 of Poveromo


'749, the light housing (i.e., lamp 78 and bars 82 and 90) is attached to the curved surface of the top portion of the fender by brackets 84 and 86 and nuts and bolts 88. Accordingly, the appellant's argument is unpersuasive and the decision of the examiner to reject claims 1 to 3, 6, 9 to 13, 15, 16, 19, 23, 27 and 39 under 35 U.S.C. § 103 as being unpatentable over Poveromo '664 in view of Poveromo '749 is affirmed.

CONCLUSION


To summarize, the decision of the examiner to reject claims 34 to 38 under 35 U.S.C. § 102(b) as being anticipated by Whitton is reversed; the decision of the examiner to reject claims 1 to 3, 6, 7, 9, 17, 29 to 31 and 39 under 35 U.S.C. § 103 as being unpatentable over Whitton in view of Caponi is reversed; the decision of the examiner to reject claims 32 and 33 under 35 U.S.C. § 103 as being unpatentable over Whitton in view of Caponi and Hardwick is reversed; and the decision of the examiner to reject claims 1 to 3, 6, 9 to 13, 15 to 17, 19, 20, 23, 24 and 27 to 39 under 35 U.S.C. § 103 as being unpatentable over Poveromo '664 in view of Poveromo '749 is affirmed with respect to claims 1 to 3, 6, 9 to 13, 15, 16, 19, 23, 27, 36 and 39 and reversed with respect to claims 17, 20, 24, 28 to 35, 37 and 38.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


JEFFREY V. NASE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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